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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,249	01/27/2004	Stephen McConnell Gates	YOR920010052US3 (16876Z)	4166
7590	09/29/2004			EXAMINER FENTY, JESSE A
Robert M. Trepp IBM CORPORATION Intellectual Property Law Dept. P.O. Box 218 Yorktown Heights, NY 10598			ART UNIT 2815	PAPER NUMBER

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	10/766,249	GATES ET AL.
	Examiner	Art Unit
	Jesse A. Fenty	2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 56-72 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 56-59 and 67-72 is/are rejected.
- 7) Claim(s) 60-66 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 56 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apen et al. (US 2003/0017635 A1).

In re claims 56 and 69, Apen (Figs. 1-5) discloses an electronic structure comprising at least one SiCOH dielectric material (polycarbosilane; section [0093], lines 18-21), having a dielectric constant of less than 3.5 (section [0093], line 26). Apen does not expressly disclose empirical values for the electric field nor leakage current of the device. However, these parameters simply appear to be functions of the thickness of the SiCOH layer (Applicant's

Specification, pp. 17, lines 1-5). Since Apen discloses SiCOH and having the claimed permittivity, it would have been obvious to one skilled in the art at the time of the invention to determine, without undue experimentation, an optimal thickness of the dielectric layer to achieve the given result.

In re claim 67, Apen discloses the device of claim 56, wherein said conductor is patterned.

In re claim 68, Apen discloses the device of claim 56, wherein said SiCOH dielectric material and said conductor are components of at least one device selected from the group consisting of an inductor and a capacitor (section [0086]).

Double Patenting

3. Claims 56-59 and 67-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of Gates et al. (U.S. Patent No. 6,737,727 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the claims of the instant application only refer to a dielectric layer and a conductor, it would have been obvious for one skilled in the art at the time of the invention to use these component parts in a complete device, because the combination of a dielectric layer and a conductor does not equal a whole device.

Allowable Subject Matter

4. Claims 60-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: The claims comprising the previous subject matter and at least a SiCOH layer including a graded composition of carbon content is neither anticipated nor obvious over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jesse A. Fenty whose telephone number is 571-272-1729. The examiner can normally be reached on 5/4-9 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on 571-272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jesse A. Fenty
Examiner
Art Unit 2815